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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,576	11/21/2000	John F. Fairclough	TRO4-BK25	2130
21611	7590	10/24/2005	EXAMINER	
SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/717,576

Applicant(s)

FAIRCLOUGH ET AL.

Examiner

John M. Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-11,16-19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

Status

Claims 1,4-7 9-11, 16-19 and 23-26 remain pending

### *Response to Arguments*

The Applicants arguments filed on August 6, 2005 have been fully considered. The amended claims are rejected in view of the newly discovered references Bartoli et al (US Patent 6,407,268)

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Walker et al. (US Patent 6,338,049) and further in view of Bartoli et al (US Patent 6,407,268).

As per claim 1,

Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network comprising the following steps:

- connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
- transmitting an order from the client computer to the merchant server; (figure 4)
- selecting payment by check; (figure 6)
- connecting the client computer to a check server;(column 13, lines 66-67; column 14, lines 1-19)
- inputting customer data at the client computer; (column 13, line 64)
- transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)
- transmitting customer data from the check server to a check verification server; (column 15, line 1-7)
- transmitting an approval from the check verification server to the check server (column 15, line 1-7)

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Pare Jr. et al. ('148) does not explicitly disclose printing a check including data from the check server as a negotiable instrument at a remote location. Walker et al ('049) discloses printing a check including data from the check server as a negotiable instrument at a remote location. (Column 6, lines 9-20) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Walker et al ('049) method in order to allow the seller to generate physical proof of the transaction.

Pare Jr. et al. ('148) does not explicitly disclose confirming the order or payment by a message from the merchant server to the client computer and the check server by sending an electronic mail message to the client computer and the check server, where the receipt of the confirming message by the check server determines whether printing of the check is permitted. Bartoli et al ('268) discloses confirming the order or payment by a message from the merchant server to the client computer and the check server by sending an electronic mail message to the client computer and the check server, where the receipt of the confirming message by the check server determines whether printing of the check is permitted. (Column 8, lines 13-55; figure 2) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Bartoli et al ('268) method in order to allow the seller to generate physical proof of the transaction.

As per claim 4,

Pare Jr. et al. ('148) discloses the method of Claim 1

Pare Jr. et al. ('148) does not explicitly disclose the check is printed by a secure printer connected to a check printing station at the remote location. Walker et al ('049) discloses the check is printed by a secure printer connected to a check printing station at the remote location (Figure 2C). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Walker et al ('049) method in order to allow the seller to generate physical proof of the transaction.

Claim 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Hills et al. (US Patent No 6,164,528)

As per claim 5,

Pare Jr. et al. ('148) discloses the method of Claim 1

Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check verification server in a merchant file in the check server; downloading the merchant file from the check server to a check printing station. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server; (Abstract) downloading the merchant file from the check server to a check printing station (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

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As per claim 9,  
Pare Jr. et al. ('148) discloses the method of Claim 6  
where the network is the Internet.(Figure 4)

As per claim 10,  
Pare Jr. et al. ('148) discloses the method of Claim 6  
where the approval comprises the customer data transmitted from the client computer to  
the check server. (column 15, line 1-7)

### ***Allowable Subject Matter***

Claims 16-19, 23-26 are allowable over the prior art record.

Claims 6,7 and 11 are objected to as being dependent upon a rejected base claim, but  
would be allowable if rewritten in independent form including all of the limitations of the base  
claim and any intervening claims.

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the  
references as applied to the claims above for the convenience of the applicant. Although the  
specified citations are representative of the teachings of the art and are applied to the specific  
limitations within the individual claim, other passages and figures may apply as well. It is  
respectfully requested from the applicant in preparing responses, to fully consider the references  
in entirety as potentially teaching all or part of the claimed invention, as well as the context of  
the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning  
this communication or earlier communications from the examiner should be directed to John  
Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on  
Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are  
unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at (571) 272-6712.  
Information regarding the status of an application may be obtained from the Patent Application  
Information Retrieval (PAIR) system. Status information for published applications may be  
obtained from either Private PAIR or Public PAIR. Status information for unpublished  
applications is available through Private PAIR only. For more information about the PAIR  
system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to  
the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-  
free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

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**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW  
October 17, 2005

A handwritten signature in black ink, consisting of a large loop followed by several horizontal strokes, is written over a faint, rectangular stamp. The stamp contains the word "SIGNED" in a bold, sans-serif font, with some smaller, less legible text below it.